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09/974,823	10/12/2001	Takashi Shimada	1086.1151	8256

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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

SWARTZ, JAMIE H

ART UNIT	PAPER NUMBER
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3694

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/974,823

Applicant(s)

SHIMADA ET AL.

Examiner

Jamie H. Swartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 7-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 7-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This final office action is responsive to applicants amendment filed March 12, 2007.

Claims 1, 7, 10, 11, 12, 14 have been amended.

Claims 3-6 have been cancelled.

Claim 16 has been added.

Claims 1-2 and 7-16 are pending.

Applicants submission of current drawings have overcome the current objection.

Responsive to applicants amendments/arguments applicants rejections under 35 U.S.C. 112 have been overcome.

Response to Arguments

2. Applicant's arguments filed March 12, 2007 have been fully considered but they are not persuasive. On pages 10-11 applicants argue that the prior art reference doesn't include the specifics of posting results of consultation received from said computer of said intellectual service cooperator to said computer of said service intermediary, and adding service intermediary transaction information to said results to create support information for provision to said service beneficiary. The examiner respectfully disagrees, as this can be found upon looking at this other part of the Broadbent reference col. 14, line 65 – col. 18, line 49 and col. 48, line 49 – col. 49, line 26. It is specifically stated in the Broadbent reference that "the loan completion status is also communicated to the Secondary Banking & Loan Inventory Management system which

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adds the completed loan data to the loan inventory and periodically, using a Secondary banking Engine, optimally packages certain loans for transfer to secondary finding sources (col. 18, lines 38-49)." It is viewed that the secondary banking & loan inventory management system is the service intermediary. When the loan is communicated to the secondary banking & loan inventory management system it is also added to the completed loan data which is the same as being "posted" to the "service intermediary."

3. Also, Examiner notes that, as per MPEP § 2144.03(C), in regards to the rejection of claim 10 the statements of Official Notice made in the art rejection have been established as admitted prior art since Applicant has not traversed the Examiner's assertions of Official Notice. More specifically, the following statements of Official Notice are now formally established on record as admitted prior art.

Official notice is taken that the practices of management diagnosis, support of going public business, publicity work, and various settlements were each individually old and well-known in the management/ public relations field at the time of the invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 2, 9, and 11-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Broadbent et al (US 6904412 B1) (referred to as Broadbent).

Referring to claims 1, 9, and 11-15, Broadbent teaches a business management support method using computers of a service provider, a service beneficiary, a service intermediary, and an intellectual service cooperator attached to a network comprising *collecting enterprise information from said computer of said service beneficiary* (col. 9, lines 8-20). The borrower uses a computer to input their personal data (col. 9, lines 34-38). Broadbent teaches *providing said collected enterprise information to said computer of said intellectual service cooperator to make a request for consultation* (col. 9, lines 19-30 and col. 14, lines 18-26). Broadbent teaches *posting results of consultation received from said computer of said intellectual service cooperator to said computer of said service intermediary, and adding service intermediary transaction information to said results to create support information for provision to said service beneficiary* (col.

12, lines 24-34 and col. 14, lines 18-26, col. 8, lines 23-45, col. 14, line 65 – col. 18, line 49 and col. 48, line 49 – col. 49, line 26). Broadbent teaches how each party involved uses a computer (col. 14, lines 18-52)

Referring to claim 2, Broadbent teaches when a *service intermediary is a bank which has dealings with said service beneficiary* (col. 12, lines 24-34).

Referring to claim 9, while the specific names of the types of parties that would serve the intellectual service cooperator (i.e., an auditing corporation, a think tank, a securities firm, and a capital gain company) are not expressly disclosed by Broadbent, the specific names of the types of parties are mere labels. The particular names of the parties do not change the requesting or the information provided in claim 1 (from which claim 9 depends). As stated in claim 9, *an auditing corporation, a think tank, a securities firm and a capital gain company* are mere labels corresponding to the type of person performing the invention and such labels do not affect any recited structure or method. Analogous to the situation in *Ex parte Pfeiffer*, 135 USPQ 31 (BdPatApp&Int 1961) where structural limitations were not entitled to weight in method claims, the recited names of parties limitation therein must affect the method in a manipulative sense. In claim 9, since the recited names of parties does not affect the method in a manipulative sense, these specific names of parties do not patentably distinguish claim 9 over the prior art.

Referring to claim 11, Broadbent additionally discloses a business management support program *run by a computer* (col. 14, lines 18-26) *of a service provider, which is connected, via a network* (col. 14, lines 27-46). Further details of claim analysis is provided under the claim 1 rejection, especially as they apply to the commonly recited claim limitations.

Referring to claim 12, Broadbent additionally teaches *a computer readable record medium having thereon recorded a business management support program to be run by a computer* (col. 7, lines 24-33). Further details of claim analysis is provided under the claim 1 rejection, especially as they apply to the commonly recited claim limitations.

Referring to claim 13, Broadbent additionally teaches a computer that acts as *an information collecting unit, a requesting unit, and an information providing unit* (col. 6 line 15 – col. 7 line 44).

Referring to claim 14, Broadbent additionally teaches *providing enterprise information in response to a request from said computer of said service provider* (col. 9, lines 8-30). Broadbent teaches *accepting the results of consultation received from said computer of said intellectual service cooperator* (col. 9, lines 8-30).

Referring to claim 15, Broadbent additionally teaches a computer that functions *as an information-providing unit which includes providing enterprise information in response to a request from said computer of said service provider* (col. 7, lines 4-44). Broadbent teaches a computer that functions *as an information-accepting unit which accepts the results of consultation received from said computer of said intellectual service cooperator* (col. 6, line 15 – col. 7, line 44).

Referring to claim 16, Broadbent teaches *an application service provider (ASP) including an ASP server* (col. 10, line 34-63, col. 16, line 7-23, col. 17, line 26-59, col. 46, line 10-51, col. 48, line 60 – col. 49, line 13). Broadbent teaches *a service beneficiary sending enterprise information to said ASP server* (col. 10, line 34-63, col. 16, line 7-23, col. 17, line 26-59, col. 46, line 10-51, col. 48, line 60 – col. 49, line 13). Broadbent teaches *an intellectual service cooperator including an intellectual service cooperating server, and receiving, in said intellectual service cooperating server, said enterprise information from said ASP server, and providing a consultation in accordance with the received enterprise information* (col. 10, line 34-63, col. 16, line 7-23, col. 17, line 26-59, col. 46, line 10-51, col. 48, line 60 – col. 49, line 13). Broadbent teaches *a service intermediary including a bank server, and receiving, in said bank server, results of said consultation, and adding service information to the results, to create support information, and providing said support information to said service beneficiary* (col. 17, line 26 – col. 18, line 55, col. 35, line 30 – 63, col. 48, line 60 – col. 49, line 13).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadbent et al (US 6904412 B1), as applied to claim 1 above, in view of O'Flaherty et al (US 6253203 B1).

Regarding claim 7, Broadbent shows information collecting, requesting, consulting, and information providing but does not show predefined follow levels. O'Flaherty, however, shows a database *that depending on predefined follow levels, masking is effected in sequence on enterprise information collected in said collecting enterprise information, enterprise information provided to said computer of said intellectual service cooperator in providing said collected enterprise information, and the results of consultation on which said computer of said service beneficiary is posted in said posting the results.* (col. 7, line 1 – col. 10, line 55, col. 14, line 65 – col. 18, line 49 and col. 48, line 49 – col. 49, line 26) Also see figures 2A-3C. O'Flaherty specifically discusses banking, mortgages (col. 1, line 57-67), financial information (col. 10, line 2-6), and the use of databases (col. 2, lines 53-56). O'Flaherty states his invention serves to prevent abuse associated with accessing personal customer information (col. 2, lines

30-40). Broadbent's invention is related to mortgage processing using databases.

Similarly, O'Flaherty's invention is related to database security and references mortgages. It would have been obvious to a person of ordinary skill in the art at the time the invention to modify Broadbent to include the data column control for extra security with the information and for consumer privacy. This allows a company to avoid passing sensitive information to people without approved access while allowing maximum use of the system without a security leak/risk as suggested by O'Flaherty.

Regarding claim 8, Broadbent shows information collecting, requesting, consulting, and information providing but does not show various follow levels or masking. O'Flaherty, however, shows different dataviews which are provide different levels of visibility into the data in the customer table using masking. The privileged view (col. 8, lines 35-50) is *when said follow level is a maximum level, said enterprise information and said results of consultation are completely indicated without masking, and wherein the standard view (col. 8, lines 5-34) is when said follow level is a minimum level, masking is made on attribute information other than requisite items in said enterprise information and said results of consultation, and wherein the anonymizing view (col. 9, lines 4-12) is when said follow level is a level lying between said maximum level and said minimum level, said attribute information is indicated partially or in a simplified manner.* Broadbent's invention uses databases while O'Flaherty invention demonstrates a more sophisticated level of database security. Database security is more critical then ever now as networks have become more open. Database security exists

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as systems, processes, and procedures that protect a database from authorized misuse, malicious attacks or inadvertent mistakes made by authorized individuals or processes. Increased database security allows a company to avoid passing sensitive information to people without approved access while allowing maximum use of the system without a security leak/risk. It would have been obvious to a person of ordinary skill in the art at the time the invention to adapt Broadbent to have a maximum and minimum level of security on the information in a database to protect their customer's information (as taught by O'Flaherty), especially since Broadbent handles very confidential finance data of their customers.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Broadbent et al (US 6904412 B1), as applied to claim 1 above.

Regarding claim 10, Broadbent shows information collecting, requesting, consulting, and information providing but does not show business management support service includes management diagnosis, support of going public business, support of publicity work for investors and support of various settlements. Official notice is taken that the practices of management diagnosis, support of going public business, publicity work, and various settlements were each individually old and well-known in the management/ public relations field at the time of the invention. These practices help to improve a business' public image, which is important in attracting and retaining customers. Since Broadbent relies on keeping its customers content for the continued

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success of its loan processing services, the Examiner submits that it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Broadbent's business management support method to include management diagnosis, support of going public business, support of publicity work for investors and support of various settlements in order to more successfully build, manage and sustain a positive image, thereby making Broadbent's services more appealing to future customers.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie H. Swartz whose telephone number is (571) 272-7363. The examiner can normally be reached on 8:00am-4:30pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jamie Swartz
April 2, 2007

Susanna Diaz
SUSANNA M. DIAZ
PRIMARY EXAMINER
AU 3694